

REMARKS

Review and reconsideration of the Office Action mailed October 2, 2007 (hereinafter "Office Action"), is respectfully requested in view of the above amendments and the following remarks. At the time of the Office Action, claims 10-19 were pending. Claims 10-19 were rejected under one or more of 35 U.S.C. § 112, second paragraph and 35 U.S.C. § 103(a). By this Amendment, claims 10 and 17 are amended and claim 11 is cancelled. No new matter is added.

Correction of Title on Record with the Patent Office

Applicants note that the Patent Office records indicate that the title of the present application is "Self-Warming Cosmetic Product." Applicants respectfully request that this be corrected to "Cosmetic Self-Warming Products." Pursuant to 37 C.F.R. 1.72, the title of the application is found at the top of the first page of the specification or in an application data sheet (ADS). Applicants did not file an application data sheet; however, the first page of the specification includes the proper title: "Cosmetic Self-Warming Products." Accordingly, Applicants respectfully request that the Patent Office update its records to reflect the proper title of this application.

Information Disclosure Statement

Applicants note that they submitted a proper information disclosure statement (IDS) on December 18, 2006. Although the Mackles PCT publication cited in the IDS serves as the basis for the pending rejections, the IDS was not acknowledged in the Office Action. Applicants respectfully request acknowledgement of the IDS in the next office correspondence.

Amendments to the Claims

By this Amendment, claims 10 and 17 are amended and new claim 20 is added. Applicants have amended claims 10 and 17 to recite "0.1 to 20 % by weight of a thickener selected from the group consisting of polyethylene, 12-hydroxy stearic acid, clay, cosmetically useful castor oil derivatives and waxes." Support for this amendment can be found throughout the specification, including paragraph [0024]-[0027]. No new matter is added.

Additional amendments to claims 10 and 17 were made to clarify that there are "no polyvalent alcohols and polar solvents are contained in the product" and to eliminate an antecedent basis problem in claim 17. No new matter is added.

Claims Rejections – 35 USC § 112, second paragraph

In the Office Action, claims 10-19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action asserts that the phrase "castor oil derivative" is indefinite because it encompasses a large number of compounds that would reasonably be expected to alter the physical and chemical properties, physiological effects and functions, of the compound.

Applicants have amended claims 10 and 17 to recite "0.1 to 20 % by weight of a thickener selected from the group consisting of polyethylene, 12-hydroxy stearic acid, clay, cosmetically useful castor oil derivatives and waxes." Applicants note that, while the hydroxyl functional group of castor oil provides the ability to create any of a variety of derivatives, a person of skill in the art would quickly understand which castor oil derivatives are cosmetically useful castor oil derivatives. In addition, a person of ordinary skill in the art would recognize

that the useful castor oil derivatives would be used as thickeners. Such cosmetically useful castor oil derivatives can be found in a variety of places, including the Cosmetic, Toiletry, and Fragrance Association International Buyers' Guide (*see* enclosed CTFA International Buyers' Guide, 2004, Vol. 2, p. 179, which include castor oil and castor oil derivatives). Accordingly, Applicants respectfully request that the rejection be withdrawn.

Claims Rejections – 35 U.S.C. § 103

In the Office Action, claims 10-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over PCT Publication WO 86/05389 to Mackles (hereinafter "Mackles WO") in view of U.S. Patent No. 4,708,812 issued to Hatfield (hereinafter "Hatfield") and U.S. Patent No. 6,274,128 issued to Bergmann *et al.* (hereinafter "Bergmann"). Claims 17-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mackles in view of Hatfield and Bergmann, and further in view of U.S. Patent No. 5,322,683 issued to Mackles *et al.* (hereinafter "Mackles US").

The Mackles WO reference is drawn to a stable, anhydrous aerosol foam that may contain a particulate solid capable of absorbing water exothermically. The anhydrous aerosol foam is prepared by combining particulate solids with a foamable liquid oil, a foaming agent and a propellant, *see* Mackles WO, Abstract. Mackles WO acknowledges that cosmetic products containing such particulate solids have not been successfully marketed because they are "very oily, greasy, and pasty in consistency; spread poorly on the skin, and leave the skin with a greasy feel and appearance," *see* Mackles WO, page 1, ln. 21-24. Mackles WO discloses that it solves this problem by utilizing a stable foam produced from an oil and a propellant, *see* Mackles WO, page 3, ln. 2-17. However, Mackles WO does not disclose or suggest a method of overcoming the above-described deficiencies without utilizing an aerosol foam that contains a propellant.

The Office Action acknowledges that Mackles WO fails to disclose the specifically claimed thickeners. Applicants note that the claimed thickeners and oil absorbent materials used in the claimed compositions help "provide a product which leaves a particularly soft, silky-like feeling on the skin," *see* Specification, paragraph [0006].

Additionally, Mackles WO provides for zeolites that contain up to 5 wt-% water, *see* Mackles WO, page 9, lines 25-26. In contrast, the claimed cosmetic products include zeolites that contain "no polyvalent alcohols and polar solvents," such as water, *see* claims 1 & 17.

As noted in the Office Action, the zeolites in Mackles WO are silicon-rich zeolites with an Si:Al ratio of 1:1 to 0:1. The silicon-rich zeolites disclosed in Mackles WO are typically used as washing powders. In contrast, zeolites of the current invention are aluminum-rich with a preferred Si:Al ratio of 2:1 to 5:1, *see* Specification, paragraph [0016] & claim 12. This gives them different heating characteristics.

Clearly, Mackles WO does not disclose the claimed compositions which use aluminum-rich zeolites and compositions that contain "no polyvalent alcohols and polar solvents." Furthermore, the compositions disclosed by Mackles WO are not capable of providing the claimed temperature rise. As discussed below, the deficiencies of Mackles WO are not corrected by any of the cited references.

Bergmann is drawn to a method for conditioning hair with warming, which includes administering the conditioner composition of the Bergmann invention. The Bergmann conditioner compositions include a carrier material that can include polar solvents and multivalent alcohols, *see* Bergmann, col. 3, ln. 22-25; col. 3, ln. 66 -- col. 4, ln. 4 & claims 5-8. The Bergmann conditioner compositions can also include up to 2 wt-% water. In contrast, the claimed cosmetic self-warming product for skin-cleansing expressly includes the "proviso that no polyvalent alcohols and polar solvents are contained" therein, claims 10, 17 & 20.

As discussed in the specification, polar solvents and multivalent alcohols reduce the water absorption potential of the zeolites, resulting in a significant reduction in the overall warming potential of the zeolite. Clearly, the combination of Mackles WO and Bergman does not disclose or suggest at least the limitation that "no polyvalent alcohols and polar solvents are contained" in the claimed cosmetic self-warming product for skin-cleansing.

Hatfield is drawn to encapsulation of phase change materials for heat exchangers, *see* Hatfield, Abstract. Hatfield discloses that

The invention relates to heat storage material such as those that are used in solid heating applications for heating interior spaces of buildings and the like. The invention more specifically relates to encapsulated phase change material for use as such heat storage material and to the processes of preparing and using such encapsulated phase change material.

Hatfield, col. 1, ln. 7-14.

As set forth in the MPEP: "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." Applicants note that Hatfield is not an appropriate reference to reject a cosmetic product because it is clearly from a non-analogous art and is not reasonably pertinent to Applicants' cosmetic endeavors, *see* MPEP 2141.01(a). *In re Clay* states that, "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *See In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

In this instance, Hatfield deals with phase change materials are useful for storing heat inside *closed system heat exchangers*, such as solar heating devices, *see* Hatfield, *e.g.*, Abstract and col 1, ln. 7-14. Because such systems are closed, they contain materials, such as thickeners, that are not acceptable for use in cosmetic compositions. Some of these materials even require

special protective equipment to avoid contact with the skin, the eyes, or the lungs. Because of the differences in the types of properties that are acceptable in these highly divergent technology areas, a person of skill in the art would not expect that thickeners used in the heat storage fluid of a heat exchanger would be useful in a cosmetic self-warming product for skin-cleansing. Accordingly, Applicants respectfully request that Hatfield be eliminated from the current rejections of the claimed cosmetic self-warming composition for skin-cleansing.

Turning to Mackles US, which the Office Action asserts discloses a self-heating foam composition comprising aluminosilicates useful as a hair conditioner and facial cleanser. Mackles US is apparently used solely to assert that the compositions disclosed by Mackles WO could be used as part of a method for skin cleansing. This simply does not suffice to disclose the claimed feature where "no polyvalent alcohols and polar solvents" are present in the self-warming cosmetic product.

Applicants note that the claimed method discloses that the composition is "formulated to cause a raise in temperature of the skin by 4 to 8 K during cleansing compared to the starting surface temperature of the skin." Mackles WO discloses zeolites with silicon-rich zeolites with an Si:Al ratio of 1.1 to 0.1. Mackles WO uses VALFOR® 950 as the exemplary zeolite, *see* Mackles WO, Examples 1-7 on p. 13 – 21. In order to demonstrate that the zeolite containing composition produced by the rejection is not capable of producing the claimed level of heating, Applicants have submitted comparative data in the Declaration of Co-Inventor Donna Hui-Ing Hwang Under 37 C.F.R. §1.132 (hereinafter "132 Declaration").

As noted in Comparative Example #1 of the 132 Declaration, when 100g of water are added to 45g of water-free VALFOR® 950, the temperature increase is $4.1^{\circ}\text{C} \pm 0.5^{\circ}\text{C}$. The current disclosure described compositions using aluminum-rich zeolites, such as MOLSIV® GMP3A, *see* Specification, paragraph [0029] & [0035]. As noted in Comparative Example #2 of the 132 Declaration, when 100g of water are added to 45g of water-free MOLSIV® GMP3A, the

temperature increase is $7.2^{\circ}\text{C} \pm 0.6^{\circ}\text{C}$. As explained in the 132 Declaration, this is a significantly different temperature increase.

However, the compositions produced according to the current rejection could include up to 5 wt-% water as well as multivalent alcohols and polar solvents. Comparative Example #2 of the 132 Declaration, demonstrates the impact of adding as little as 5 mg of water to the 45 mg samples of Comparative Example #1. The addition of 5 mg of water to the silicon-rich VALFOR® 950 resulted in a temperature increase of $1.2^{\circ}\text{C} \pm 0.31^{\circ}\text{C}$; while the same addition to the aluminum-rich MOLSIV® GMP3A resulted in a temperature increase of $1.9^{\circ}\text{C} \pm 0.33^{\circ}\text{C}$.

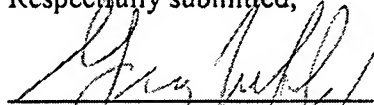
However, the more important information is the impact that the presence of water has on the zeolites when they are exposed to significant amounts of water, such as those used during face washing. Thus, the wetted zeolites were allowed to stand for 2 hours before they were contacted by 100g of water. The addition of 100 mg of water to the pre-treated silicon-rich VALFOR® 950 resulted in a temperature increase of only $3.4^{\circ}\text{C} \pm 0.41^{\circ}\text{C}$; while the same addition to the pre-treated aluminum-rich MOLSIV® GMP3A resulted in a temperature increase of $6.0^{\circ}\text{C} \pm 0.34^{\circ}\text{C}$. Clearly, the composition produced by the suggested rejection is not capable of "rais[ing] in temperature of the skin by 4 to 8 K during cleansing compared to the starting surface temperature of the skin."

Clearly, none of the references, whether alone or in combination, disclose each of the claimed features of the claimed invention. Furthermore, there would be no motivation to combine the references in order to produce the claimed invention. This is particularly true now because "clay," which is the lone link between Mackles WO and Hatfield has been eliminated from the list of claimed list of thickeners.

Conclusion

For at least the reasons set forth above, the independent claims are believed to be allowable. In addition, the dependent claims are believed to be allowable due to their dependence on an allowable base claim and for further features recited therein. The application is believed to be in condition for immediate allowance. If any issues remain outstanding, Applicant invites the Examiner to call the undersigned if it is believed that a telephone interview would expedite the prosecution of the application to an allowance.

Respectfully submitted,



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